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CENTRAL FAX CENTER****OCT 04 2006****REMARKS****I. General**

The issues outstanding in the instant application are as follows:

- The Office Action has been improperly made final;
- The claims are subject to a restriction requirement;
- Claim 6 stands unexamined in the present Office Action and the present Office Action fails to respond to the arguments and amendments presented to claim 6 in the Amendment of September 16, 2005; and
- Claims 1-5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Huang, United States Patent Number 6,318,763 (hereinafter *Huang*).

Applicant respectfully traverses these requirements and rejections and requests reconsideration in light of the amendments presented above and the arguments presented below. A paragraph of the specification has been amended above to correct typographical errors. No new matter has been added by these amendments. Claims 1-6 are currently pending in this application.

II. The Office Action has been improperly made final

Applicant respectfully points out that in accordance with M.P.E.P. §706.07(a) "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement" (emphasis added).

Further, Applicant respectfully reminds the Examiner that in accordance with 37 CFR § 1.142(a), second sentence, and M.P.E.P. § 811 a restriction requirement "may be made at any time before final action" (emphasis added).

Applicant respectfully asserts that the restriction requirement presented in the present Office Action is a new grounds of rejection, particularly in light of the Office Action not addressing claim 6, on the merits. In other words, by making the present action final, the Examiner has denied Applicant a full and fair opportunity to assess the patentability of the pending claims, particularly claim 6, as discussed in greater detail below. Furthermore,

Applicant respectfully asserts that initial presentation of a restriction requirement in an Office Action means that that Office Action cannot be made final in that 37 CFR § 1.142(a) requires that a restriction requirement be made at a time before a final action on the merits. Applicant respectfully asserts that the present restriction requirement is, at best, being made at the time of final action on the merits. For these reasons, Applicant respectfully requests that the Examiner remove the finding of finality and process a refund of the accompanying RCE fee.

III. Response to Restriction Requirement

In accordance with the dictates of the rules concerning properly responding to a restriction requirement, Applicant provisionally elects the Invention of Group I (claims 1-5), **with traverse.**

Applicant respectfully points out that M.P.E.P. § 803 requires: "If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." In the present case, the Examiner has already examined all of claims 1-6 and opined as to their patentability in the Office Action of July 6, 2004. The amendments made to claim 6 in Applicant's September 16, 2005 Amendment includes limitations speaking to a collar, similar to limitations already present in the other independent claims. Therefore, Applicant respectfully asserts that there is no serious burden on the Examiner to search and examine all of the claims, as he has already searched and examined the claims and their various limitations.

Additionally, M.P.E.P. § 811 states:

the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops. Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required. (Emphasis added.)

Hence, Applicant respectfully asserts that since, as discussed above, it would not present a serious burden for the Examiner to search and examine all of the pending claims it is improper for the Examiner to present this restriction at this late point in the examination of this application.

Finally, the Examiner's logic for making the restriction requirement is flawed. The Examiner indicates that the inventions are distinct because "the product as claimed (in claims 1-5) can be made by another and materially different process such as a heated press-fit." (Parenthetical indication added). Applicant respectfully points out that each of the independent claims, claims 1, 2 and 4, recite an element such as "said collar support portion including knurling and an axial stop ring." Applicant respectfully asserts that inclusion of knurling and an axial stop ring in a collar support portion of a fitting insert cannot be accomplished by heated press fitting or the like. Further, each of independent claims 1, 2 and 4 (of alleged Invention Group I) recite elements speaking to the torque communication portion being staked to provide communication with the knurling in a relatively non-rotational manner. Similarly, independent claim 6 (of alleged Invention Group II) recites "staking said collar at said torque communication portion to affix said collar upon said stem in a relatively non-rotational manner." Thus, Applicant fails to understand how one might employ a materially different process such as a heated press-fitting to make the product of claims 1-5 by another and materially different process.

In light of each of the foregoing defects in the present restriction requirement, Applicant respectfully asserts that the restriction requirement should be withdrawn, the finality of the present Office Action should be withdrawn, and that claim 6 should be examined, on the merits.

IV. Claim 6 stands unexamined in the present Office Action;

The Office Action Summary indicates that claim 6 has been withdrawn from consideration. However, the above discussed restriction requirement was first advanced in the present Office Action. Thus, Applicant has not had an opportunity, prior to this Amendment/Response, to make an election or to address the propriety of the restriction requirement.

Applicant respectfully contends that by imposing the restriction requirement in the final Office Action and by assuming to examine the claims of Group I while ignoring the claim in group II, the Office Action fails to comport with Office policy. Specifically, the Examiner is directed that "[i]n accordance with the patent statute, 'Whenever, on examination, any claim for a patent is rejected, or any objection . . . made', notification of the reasons for rejection

and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given," M.P.E.P. § 707. As such the Examiner has not "clearly articulate[d] any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity," M.P.E.P. § 706.

Applicant therefore respectfully requests that the Examiner remove the finding of finality, examine claim 6 and process a refund of the accompanying RCE fee.

V. Rejections under 35 U.S.C. § 102

As noted, claims 1-5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Huang*. Applicant respectfully traverses these rejections for the reasons advanced below.

It is well settled that to anticipate a claim, a reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 USP.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejections of the do not satisfy one or more of these requirements, as detailed below.

Independent claims 1, 2 and 4 each recite "said collar support portion including knurling." The Office Action cites teeth 100 of *Huang* as teaching this element. Applicant respectfully points out that *Huang* clearly teaches in its abstract, and elsewhere, a connecting pipe having multiple teeth and a locking sleeve having multiple notches defined thereon and corresponding to the teeth of the connecting pipe. Further, in column 3, lines 46 and 47, *Huang* describes that "the connecting pipe (10) teeth (100) can be locked by the locking sleeve (14) notches." As one of ordinary skill in the art would appreciate, in the context of independent claims 1, 2 and 4, "knurling" is a roughened surface, or the like. Thus, a set of teeth defined to match, mate and lock with corresponding notches cannot be fairly characterized as teaching or suggesting such knurling. Particularly, Applicant respectfully asserts that not only does *Huang*

do not teach (or suggest) the knurling of the present independent claims, *Huang* also fails to show the identical invention in as complete detail as is contained in the independent claims.

Further, the independent claims recite "said ferrule support portion adapted to be staked in such a manner that said inner periphery extending through said ferrule support portion communicates with said axial stop ring in an axial movement limiting manner." The Office Action includes a labeled copy of Figure 4 of *Huang* indicating a stop ring. However, Applicant respectfully points out that neither Figure 4, none of the other Figures of *Huang*, nor the text of *Huang* show, teach or suggest that a portion of locking sleeve 14 of *Huang* may be staked such that an inner periphery of the locking sleeve would contact or otherwise communicate with the indicated stop ring. In fact, in each of Figures 3 and 4 of *Huang* the portion of locking sleeve 14, shown as deflected inward is spaced apart from the indicated stop ring. Thus, *Huang* clearly fails to teach (or suggest) "said ferrule support portion adapted to be staked such that said inner periphery extending through said ferrule support portion communicates with said axial stop ring in an axial movement limiting manner, as recited by each of independent claims 1, 2 and 4.

In addressing each of independent claims 1, 2 and 4, and Applicant's previous arguments, the Office Action states:

a comparison of the recited process with the prior art process does NOT serve to resolve the issue concerning patentability of the product. In *re Fressman*, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In *re Klug*, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an *ex parte* case, product-by-process claims are not construed as being limited by the product formed by the specific process recited. In *re Hirao et al.* 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976). Therefore, the limitation of staking is given little patentable weight.

Applicant respectfully asserts that independent claims, as previously pending, were not product-by-process claims in that the claims were not defined only in terms of the process steps employed to produce the product. Conversely, independent claims 1, 2 and 4 defined elements which were described as "staked." This is clearly no more a product by process element than elements being described as threaded together, or the like.

Still, as pointed out in M.P.E.P. § 2113:

[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted in M.P.E.P., emphasis added by Applicant)

Applicant respectfully points out that the Office Action fails to show how the product in alleged product-by-process claims 1-5 are the same as or obvious from a product of the prior art. The Office Action only states "the limitation of staking is given little patentable weight." Regardless, of the weight attributed to the staking elements of independent claims 1, 2 and 4, the office action fails to show how these elements are anticipated by (or rendered obvious in light of) *Huang*. Thus the Office Action has failed to show how *Huang* teaches every element of the claims, arranged as required by the claims.

Nevertheless, Applicant has amended independent claims 1, 2 and 4 to clarify that the torque communication portion, and the ferrule support portion, are "adapted to be staked in such a manner that" the inner periphery extending through the torque communication portion communicates with the knurling in a relatively non-rotational manner, and the inner periphery extending through the ferrule support portion communicates with the axial stop ring in an axial movement limiting manner, respectively.

As a result, Applicant again asserts that *Huang* simply does not disclose or otherwise suggest the locking sleeve 14 being staked to affix it to stem 10 in a relatively non-rotational manner. Rather, *Huang* relies on the locking of the connecting pipe teeth (100) and locking sleeve notches (140) to arrest rotation. Regardless, staking is not the only, or even obvious, method that can be employed to affix locking sleeve 14 to stem 10. *Huang* does not discuss staking nor depict any example of staking. Accordingly, the applicant believes that *Huang* does not reveal every element of the claim, as is required for the reference to anticipating, and thus further fails to anticipate independent claims 1, 2 or 4.

For at least the above reasons, Applicant respectfully asserts that independent claims 1, 2 and 4 are patentable over the 35 U.S.C. § 102 rejections of record. Furthermore, there are great differences between these claims and the art of record, and a person of ordinary skill in the art considering the prior art would not find these differences obvious. Additionally,

independent claim 6 recites similar and other novel elements and is also patentable over the cited art.

Claim 3 depends directly from independent claim 2 and claim 5 depends directly from independent claim 4. Thus, each of claims 3 and 5 inherit all elements of respective claims 2 and 4. Therefore, for at least the reasons advanced above in addressing the anticipation rejection of claims 2 and 4, each of claims 3 and 5 set forth features and elements not recited by *Huang*. Hence, Applicant respectfully asserts that claims 3 and 5 are also patentable over the 35 U.S.C. § 102 rejections of record.

VI. Conclusion


For at least the reasons given above, Applicant submits that the restriction requirement should be withdrawn, that the finality of the Office Action should be removed, that claim 6 should be examined on the merits, and that the pending claims distinguish over the prior art of record under 35 U.S.C. § 102. Accordingly, Applicant submits that this application should be found in condition for full allowance.

The fees necessary for the accompanying RCE and Petition for Extension of time are dealt with in the accompanying transmittals and/or the RCE and/or Petition themselves. Applicant believes no further fee is due with this response and that, in accordance with points advanced above, the RCE fee should be refunded. However, if any additional fee is due, please charge Deposit Account No. 07-0475, from which the undersigned is authorized to draw. Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that the attorney can be helpful in resolving any remaining issues or can otherwise be helpful in expediting prosecution of the present application.

JLM
Denver, Colorado

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Respectfully submitted,


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